

## REMARKS

In the outstanding Office Action, the Examiner rejected claims 1-7 and 14-16. Applicant amends claims 1 and 14, and adds new claims 28-30. Claims 1-7, 14-16, and 28-30 are pending and under consideration.

### Objections to the specification

The Examiner objected to the title and the abstract of the specification. In particular, the Examiner stated that “[t]he title of the invention is not descriptive.” In addition, the Examiner stated that “[t]he abstract of the disclosure is objected to because the abstract is not drawn to the claimed invention, i.e. method.” In response, Applicant amends the title and abstract and asserts that these amendments overcome the Examiner’s objections.

### Rejection under 35 U.S.C. § 102(b)

The Examiner rejected claims 1-3, 6, and 7 under 35 U.S.C. § 102(b) as being anticipated by United States Patent No. 5,259,099 to Banno et al. (“Banno”). Office Action at pages 3-4.

Applicant has amended claim 1 to recite, in part, “[a] method of making a piezoelectric film comprising . . . applying said matrix material to one or more surfaces of a member, wherein said member includes a handle, a ski apparatus, or a handle and a ski apparatus.” Applicants respectfully assert that Banno does not teach or suggest this.

In fact, nowhere does Banno teach or disclose the step of “applying said matrix material to one or more surfaces of a member, wherein said member includes a handle, a ski apparatus, or a handle and a ski apparatus . . .,” as recited by amended claim 1. Indeed, Banno does not even disclose handles or ski apparatuses at all. Therefore, Applicant respectfully submits that the rejection of claim 1 under Banno should be withdrawn for at least the above reasons. Claims 2-7 ultimately depend from claim 1. Thus, these claims are allowable for at least the same reasons discussed above for claim 1.

Rejection Under 35 U.S.C. § 103(a):

In the outstanding Office Action, the Examiner rejected claims 5 and 14-16 under 35 U.S.C. § 103(a) as being unpatentable over Banno in view of U.S. Patent No. 5,792,379 to Dai et al. (“Dai”). In addition, the Examiner rejected claim 16 under 35 U.S.C. § 103(a) as being unpatentable over Banno in view of Dai and further in view of U.S. Patent No. 3,958,161 to Dixon (“Dixon”). Office action at pages 4-6.

Claim 5 depends from claim 1. As discussed above, applicant has amended claim 1 to recite, in part, “[a] method of making a piezoelectric film comprising . . . applying said matrix material to one or more surfaces of a member, wherein said member includes a handle, a ski apparatus, or a handle and a ski apparatus.” Dai does not cure Banno’s deficiency. In particular, nowhere does Dai teach or disclose the step of “applying said matrix material to one or more surfaces of a member, wherein said member includes a handle, a ski apparatus, or a handle and a ski apparatus . . .,” as recited by amended claim 1. Indeed, Dai does not even disclose handles or ski

apparatuses at all. Therefore, for at least the same reasons discussed above for claim 1, applicant asserts that claim 5 is patentable over the cited art.

Amended claim 14 recites, in part, “[a] method of making a piezoelectric film comprising . . . molding said matrix material onto a surface of a member . . . wherein said piezoelectric film facilitates a substantial dampening of vibrations from said member.” Applicant respectfully asserts that neither Banno nor Dai teach or suggest this.

In fact, neither Banno nor Dai teach or suggest dampening of vibrations at all. At best, Dai discloses a vibration mill used to facilitate the mixing of the disclosed compositions. See, e.g., column 3, lines 35-37 and column 5, lines 1-5. Upon a reading of both the Banno and Dai references, one cannot fairly describe that they teach dampening of vibrations from any member described within. Applicant argues that it is only through the use of an impermissible hindsight reconstruction of the references that he is able to ascribe these teachings to either the Banno or the Dai references.

In view of the foregoing remarks, Applicant respectfully submits that the Banno-Dai combination fails to teach or disclose “[a] method of making a piezoelectric film comprising . . . molding said matrix material onto a surface of a member . . . wherein said piezoelectric film facilitates a substantial dampening of vibrations from said member...” as recited by claim 14. Indeed, each reference in this combination fails to teach this claim element, thus the combination of the two references fails to teach this as well.

For at least the reasons discussed above, Applicant respectfully submits that claim 14 is patentable over the Banno-Dai combination. Claims 15-16 ultimately depend from claim 14. Thus, these claims are allowable for at least the same reasons discussed above for claim 14.

New Claims 28-30:

Applicant has added new claims 28-30, which are similar, but not identical, to claims 14-16. Support for these claims can be found in the specification at, e.g., paragraphs [049] to [054]. In addition, neither Banno nor Dai teach or suggest “[a] method of making a piezoelectric film . . . wherein said piezoelectric film facilitates a transfer of heat to said member.” Therefore, applicant submits that claims 28-30 are also patentable over the cited art.

In view of the foregoing arguments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

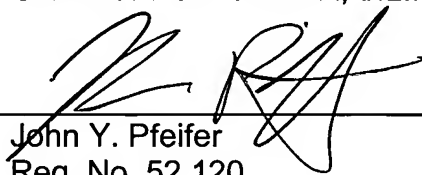
Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

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Dated: January 20, 2005

By: \_\_\_\_\_

  
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